

VIA FACSIMILE

Date of Deposit: July 21, 2004

Attorney Docket No.: 20363-011 #29

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS : Silver *et al.*

SERIAL NUMBER : 09/834,778

EXAMINER : Daniel M. Sullivan

FILING DATE : April 12, 2001

ART UNIT : 1636

FOR : SELF-EXTINGUISHING RECOMBINASES, NUCLEIC ACIDS ENCODING THEM
AND METHODS OF USING THE SAME

MAIL STOP PETITIONS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

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OFFICE OF PETITIONS

**PETITION UNDER 37 C.F.R. §1.313(c)(2) TO WITHDRAW FROM ISSUE
AFTER PAYMENT OF ISSUE FEE**

Pursuant to 37 C.F.R. §1.313(c)(2), this petition is submitted to withdraw the above-referenced patent application from issue for further action and for good and sufficient reason, as articulated below.

As an Issue Fee in the amount of \$995.00 was paid on February 6, 2004 in the above-referenced patent application. Applicants file present petition in accordance with 37 C.F.R. §1.313(c)(2) and request consideration of the Request for Continued Examination (RCE) under 37 C.F.R. §1.114 which is transmitted herewith.

The good and sufficient reason for the submission of the instant petition to withdraw this application from issue is to perfect the priority claim to U.S.S.N. 60/196,338, filed on April 12, 2000. Although a priority claim to this application was included in the executed oath and declaration submitted on July 30, 2001 and was indicated on the updated filing receipt mailed on August 20, 2001, in the Notice of Allowability mailed November 6, 2003, the Examiner indicated that the instant application did not contain specific reference to this provisional application in the first sentence of the specification, as required under 37 C.F.R. § 1.78(a)(5). As suggested by the Examiner, Applicants filed a Petition under 37 C.F.R. § 1.78(a)(6) on November 14, 2003. Applicants also filed an Amendment Under 37 C.F.R. § 1.312 on that date. In a Decision mailed on June 15, 2004, the Office of Petitions dismissed the Petition Under 37 C.F.R. § 1.78(a)(6) as moot, as such a petition is only applicable to applications filed on or after

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November 29, 2000. Moreover, in a Response to Rule 312 Communication mailed on July 9, 2004, the Examiner disapproved the Applicants' Rule 312 Amendment.

As the issue fee in the above-referenced case was paid on February 6, 2004, Applicants submit herewith for consideration an RCE under 37 C.F.R. § 1.114 along with a Preliminary Amendment to amend the specification to include a specific reference to this provisional application (the submission) along with the required fee under 37 C.F.R. § 1.17(e). Thus, Applicants respectfully request that the instant application be withdrawn from issue for consideration of this RCE in accordance with 37 C.F.R. §1.313(c)(2).

Applicants authorize payment in the amount of \$130.00 for payment of the petition fee under 37 C.F.R. 1.17(h) and in the amount of \$385.00 for payment of the RCE fee under 37 C.F.R. 1.17(e) to be charged to the undersigned's account, Deposit Account No. 50-0311 (Ref. No. 20363-011). Although Applicants believe no additional fees are due, the Commissioner is authorized to charge any additional fees that may be due, or to credit any overpayment to Deposit Account No. 50-0311.

Respectfully submitted,

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Dated: July 21, 2004

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